



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/222,906	12/30/1998	WILLIAM C. DELEEUW	22076026	2520

23838 7590 09/15/2003

KENYON & KENYON
1500 K STREET, N.W., SUITE 700
WASHINGTON, DC 20005

EXAMINER

HUYNH, CONG LAC T

ART UNIT PAPER NUMBER

2178

DATE MAILED: 09/15/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

14

Office Action Summary

Application No.

09/222,906

Applicant(s)

DELEEUW, WILLIAM C.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

4

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 7/15/03 to the application filed on 12/30/98.
2. Claims 1-19 are pending in the case. Claims 1, 8, 15, 18 are independent claims.
3. The rejections of claims 15-17 under 35 U.S.C. 112, second paragraph, as being indefinite have been withdrawn in view of the amendment.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-5, 8-12, 18-19 remain rejected under 35 U.S.C. 102(e) as being anticipated by Yokomizo et al. (US Pat No. 5,907,835, 5/25/99, filed 11/17/95).

Art Unit: 2178

Regarding independent claim 1, Yokomizo discloses:

- processing a file with a printer driver module to generate a representation having a modified format *for output by a printer* (col 2, lines 24-27: *an electronic filing apparatus capable of accumulating the information to be transmitted from an application software to a printer driver in the database; it was known that the format of a file for printing is modified to obtain a print format*)
- extracting text information from said representation (col 9, lines 22-38: *"...layout information is extracted by the block selection program ...the extracted information is the rectangular area information having the profile of text area or image area; col 6, lines 49-53: "character information is directly extracted from the GDI codes transferred to the driver"; it is noted that the GDI codes are the text information*)

Regarding claim 2, which is dependent on claim 1, Yokomizo discloses that said extracted information is a text string (col 9, lines 22-38: *"..the information ...as keyword, is extracted from the text information by the keyword extraction program..."; the information is extracted from the text information shows that the extracted information should be a text string).*

Regarding claim 3, which is dependent on claim 2, Yokomizo discloses that said extracted information includes at least one text characteristic of said text string (col 9, lines 22-38: *"..the information ...as keyword, is extracted from the text information by*

Art Unit: 2178

the keyword extraction program..."; the extracted information includes keywords which is the text characteristic of the text string).

Regarding claim 4, which is dependent on claim 3, Yokomizo discloses storing said text string and said at least one text characteristic of said text string in a database (col 9, lines 22-38: "...the information ...is extracted from the text information ...and *stored in the database*¹³ through the database API 32").

Regarding claim 5, which is dependent on claim 4, Yokomizo discloses:

- launching an owning application used to create said file (col 10, lines 4-22: "...the *application prepares a document and stores it in the electronic file...*")
- instructing said owning application to print said file using said printer driver module (col 10, lines 30-41: "...upon *selection of a print menu, a print start message is sent to the OS....upon reception of the print start message from the application, starts the driver...*having received the GDI code, the OS *transfers said GDI code* without change to the printer driver if the GDI printer driver is employed...")

Claims 8-12 are for a set of instructions for executing the method claims 1-5, and are rejected under the same rationale.

Claims 18-19 are for an apparatus for method claims 1 and 5, and are rejected under the same rationale.

Art Unit: 2178

The apparatus further includes the extraction printer driver module to convert printing instructions from the extraction application module into a format for output.

Yokomizo discloses converting printing instructions from the extraction application module into a format for output (col 10, lines 30-58: "in case ofa GDI service for converting the GDI codes into a bit map in the OS, and the bitmap is transferred to the filing driver ... the filing driver analyzed the received GDI code ... sends printing completion...."). This shows that Yokomizo system inherently includes the extraction printer driver module.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-7, 13-17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Yokomizo et al. (US Pat No. 5,907,835, 5/25/99, filed 11/17/95, priority 11/18/94).

Regarding claim 6, which is dependent on claim 5, Yokomizo does not disclose:

- obtaining a current list of files and a previous list of files
- comparing said current list with said previous list to identify new files and modified files

- repeating the processing, extracting, and storing for each new file and each modified file

Instead Yokomizo discloses:

- storing extracted information in the database (col 9, lines 34-38)
- analyzing and classifying text documents (col 13, lines 42-48)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Yokomizo to include the current list of files and a previous list of files since the feature of storing extracted information in the database suggests that the data stored in the database should form a list of files in the database.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Yokomizo to include comparing said current list with said previous list to identify new files and modified file because of the following reason. It was well known in document processing that each file when created or modified, has an associated time and date of creating and modifying to be stored along with the file. So, based on that, a file is easily recognized being a new file or a modified file.

In addition, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have incorporated repeating the processing, extracting, and storing steps for each new file and each modified file since there is a plurality of information to be extracted to store in the database as files, the processing, extracting, and storing the files need to be repeated for each of the files.

Art Unit: 2178

Regarding claim 7, which is dependent on claim 6, Yokomizo discloses searching said database for at least one document which includes desired text (col 9, lines 34-38, ..the stored document can be easily viewed by the search module; col 15, lines 42-52, *registering text information in the database...database search means for effecting search of text information in the database*; col 16, lines 1-9, the database search means 14 searches the entire text information registered in the database...).

Claims 13-14 are for a set of instructions for executing the method claims 6-7, and are rejected under the same rationale.

Claims 15-17 are for a system for the method claims 1 and 5, and are rejected under the same rationale.

The system further includes:

- a cataloging device which including a processor adapted to be connected to a computer readable memory
- a database and a network connected to said cataloging device
- the attraction printer driver module to convert the file for extracting information into a format for output by a printer
- *a searching application module included within said computer readable memory, the searching application to search for text information from the converted file*

Yokomizo discloses:

Art Unit: 2178

- a database is connected to the cataloging device (figure 1, the computer 100 is connected to the database 13)
- a network is connected to the cataloging device (col 4, lines 53-55, a database API 10-4 is used for connection to a database which can be a local one or a remote one connected through a *network*)
- converting the file for extracting information into a format for output by the printer (*col 6, lines 49-53: character information is directly extracted from the GDI codes transferred to the driver; and col 10, lines 30-58: "in case ofa GDI service for converting the GDI codes into a bit map in the OS, and the bitmap is transferred to the filing driver ... the filing driver analyzed the received GDI code ... sends printing completion...."*)
- *the searching application module included within said computer readable memory, the searching application to search for text information from the converted file (col 18, lines 22-64: "the database search means releases the document image file name or the file name but there may be instead provided application activating means and, in case document information prepared by an ordinary application is searched, such application may be activated...it is therefore rendered possible to effect text search with a high accuracy, and to effect search also for the document image entered by the scanner, with similar operations..."*)

Yokomizo does not disclose a cataloging device which including a processor adapted to be connected to a computer readable memory.

Art Unit: 2178

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Yokomizo to include the cataloging device since it was well known that any computer includes a processor which is connected to a computer readable memory. These two parts connected together are considered equivalent to the cataloging device as claimed.

Response to Arguments

8. Applicant's arguments filed 7/15/03 have been fully considered but they are not persuasive.

Applicants argue that Yokomizo fails to disclose extracting text information from the representation having a modified format generated by the printer driver module for output by a printer, as recited in amended claims 1, 8, and 18. The reason for that is the extraction that Examiner refers to occurs prior to the conversion of the GDI codes by the printer driver into the print data format or conversion into the common data format, and the extraction, therefore, is not from the representation from the printer driver module but from the original application file (Remarks, pages 6-7).

Examiner respectfully disagrees.

The portion of Yokomizo that Applicants argue (col 4, lines 18-21) is not the portion that the Examiner cited (col 6, lines 49-53 and col 9, lines 22-38).

However, as stated by Yokomizon in that portion, the data to be transferred to the printer driver is GDI in case of Windows.

Art Unit: 2178

Yokomizo further discloses (as cited by Examiner) that the character information is directly extracted from the GDI codes transferred to the driver (col 6, lines 49-53).

Obviously, the extraction of character information is from the representation from the printer driver module, not from the original application file since the GDI codes are not the original application file. The GDI codes *are converted from the original application file and then transferred to the driver, where said codes are considered as representation of the printer driver module.*

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2178

Nakatsuka (US Pat No. 5,696,841, 12/9/97, filed 10/12/93).

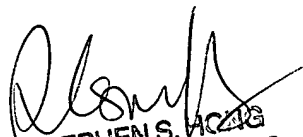
Kupcho et al. (US Pat No. 5,670,995, 9/23/97, filed 12/18/95).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 707-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

clh
8/30/03


STEPHEN S. HERTZ
PRIMARY EXAMINER